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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,375	12/15/1999	JEAN-LOUIS GUERET	2350-76	3736

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NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,375

Applicant(s)

GUERET, JEAN-LOUIS

Examiner

Frank I. Choi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,7-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,7-9,15,17-26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 4,7-26 and 28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

This application contains claims 10-14, 16 drawn to an invention nonelected with traverse in Paper No. 5. New claim 28 appears to be directed to the elected invention and will be prosecuted accordingly. Claims 4, 7-26, 28 are currently pending with claims 10-14, 16 withdrawn from prosecution as directed to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 28 recites a kit, however, page 1 of the Specification which Applicant indicates provides support does not appear to disclose a kit. As such, it does not appear that one of ordinary skill in the art would have immediately envisaged a kit from the teachings of the disclosure at the time the Application had been filed.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

The fact that the cosmetic device may be prepared by a user does not change the fact that the Specification does not recite term "kit". See *In re Rashig*, 154 USPQ 118, 123 (CCPA 1967) (Court held that although it would have been easy to imagine the specified compound from the

Art Unit: 1616

disclosure, the problem is that there was no disclosure of the specified compound). As such, the rejection is maintained herein.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4,7-9, 15, 17-26,28 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that said claims fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 5 filed 11/6/00 and Paper No. 17 (10/27/2003). In paper no. 5, applicant has stated the compositions contain no water and then in paper no. 17 modified it to substantially no water, and this statement indicates that the invention is different from what is defined in the claim(s) because the claims do not clearly indicate that they may not contain substantial amounts water. Examiner as duly considered Applicant's arguments but deems them unpersuasive.

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 190 USPQ 461, 463 (CCPA 1976). When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 143 USPQ 256 (CCPA 1964). MPEP Section 2111.03. Applicant does not appear to have met its burden of showing that addition of substantial amounts of water would materially change the characteristics of its invention. In the first instance, Applicant has made no showing as to what constitutes "substantial" amounts of water or that the Specification

Art Unit: 1616

supports the implicit incorporation of said limitation into the claims. Further, the fact that the claim recites "solution" does not support Applicant's argument that substantial amounts of water are excluded. The Specification clearly indicates that water-absorbable and water-soluble components can be part of the claimed invention, that the claimed invention can be a dispersion and contemplates the addition of water (i.e. hydration) (Pg. 4, lines 28,29, 33-34, Pg. 5, lines 13-27).

Applicant argues that a solution is homogenous whereas because addition of substantial amounts of water would result in two phases, therefore, a solution excludes substantial amounts of water. Again, Applicant does not define how much water constitutes substantial amounts of water. Further, a liquid containing more than one phase can be homogenous. See Smith et al. (US Pat. 5,254,109), Column 20, lines 40-68, Column 21, lines 1-20; Roechling et al. (US Pat. 4,870,103), Column 4, Example 4). Applicant argues that the solution has to evaporate at room temperature once applied onto a support and that this has to be fast given that the cosmetic device may be prepared with the solution just prior to use. Applicant then concludes that one of ordinary skill in the art would conclude that substantial amounts of water in a solution according to the invention will deprive the solution of the ability to quickly evaporate at room temperature. However, the solution claims do not contain these limitation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, Applicant has provided no evidence as to what would constitute substantial amounts of water or what effect said undefined amount of water would have on evaporation. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 145 USPQ 716, 718

Art Unit: 1616

(CCPA 1965); In re Geisler, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 7-9, 15, 17-22, 25, 26, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higo et al. (WO 96/16642) for the reasons of record set forth in the prior Office Actions in further view of Hori et al. (US Pat. 4,500,683) and the further reasons below.

Higo et al. was discussed in the prior Office Actions and the same is incorporated herein.

Hori et al. disclose that alkyl acrylate, acrylic acid, vinyl acetate pressure sensitive adhesives which provide high cohesive strength and high adhesive strength without using crosslinking agents, for example an adhesive strength of 840 g/20 mm (Column 1, lines 42-46, Columns 2, 3, Column 3, lines 5-43).

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

Applicant appears to be arguing that one of ordinary skill in the art would not have found incentive from the cited art to combine the teaching of Hori et al. with the teaching of Higo et al. because Hori et al. does not mention or suggest the same advantages as Applicant's claimed invention. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by

Art Unit: 1616

applicant. In re Linter, 173 USPQ 560 (CCPA 1972); In re Dillon, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FIC

March 19, 2005




SABIHA QAZI, PH.D
PRIMARY EXAMINER